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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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9978

26884

7590

03/12/2003

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EXAMINER

NGUYEN, KIMBERLY D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,632

Applicant(s)

BLANFORD ET AL.

Examiner

Kimberly D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Obviousness-Type Double Patenting

1. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,158,660. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the patent '660. For example, in claim 1 of the present claimed invention and the patent '660, the applicants claim "a scanner for detecting and decoding primary and supplemental barcode labels, comprising:"

a. "a laser for generating light", whereas in the patent '660, the Applicants claim "a laser for generating light" (col. 6, line 47);

b. "a video receiver assembly for detecting light patterns produced by a reflection of the light generated by the laser from one or more barcode labels passing within a field of view of the video assembly and producing data based on the light patterns", whereas in the patent '660, the Applicants claim "a video receiver assembly for detecting light patterns produced by a reflection of the light generated by the laser from one or more barcodes passing within a field of view of the video assembly and producing data based on the light patterns" (col. 6, lines 48-53);

"a controller for analyzing the data produced by the video receiver assembly to detect a plurality primary barcode label, the controller being operative upon detection of a primary barcode label to search a database for the bar code represented by the primary bar code label and retrieve a value associated with the bar code, the controller being operative to conduct a search for a supplemental barcode label based on the value associated with the retrieved value",

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whereas in the patent '660, the Applicant claim "a controller for analyzing the data produced by the video receiver assembly to detect a plurality primary barcode labels, including a primary label, the controller being able to be set to a supplemental babel, the controller being able to be set to a supplemental label mode in which the scanner is operative to detect the primary label and recover primary label data, initiate a delay upon detection of the primary label, and attempt to detect a supplemental label and recover supplemental label data, the controller being operative to process the primary label data if no supplemental label is detected within the delay period, the controller being operative to process both the primary label data and supplemental label data if the supplemental label is detected during the delay period" (col. 6, lines 54-67).

Thus, in respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teachings of the patent '660 as a general teachings for a scanner for detecting and decoding primary and supplemental barcode labels as claimed by the present application. The instant claims obviously encompass the claimed invention of patent '660 and differ only in terminology. To the extent that the instant claims are broaden and therefore generic to the claimed invention of patent '660, In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37

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C.F.R. 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78(d).

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaslow (US 3,959,624) in view of Gupta (US 5,382,779).

Re claims 1, 5-6 and 11-14: Kaslow teaches a scanner for detecting and decoding primary and supplemental barcode labels, comprising:

a controller for analyzing the data (figs. 4-5; col. 5, lines 39-53) to detect a plurality primary barcode labels 19, the controller being operative upon detection of a primary barcode label 19 to search a database (i.e., the group of items purchased information/signal is stored in

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the memory 25, which serves as a database) for the barcode represented by the primary barcode label and retrieve a value associated with the barcode (i.e., the signal resulting from the primary barcode 19 is fed to a comparator 26 when it compares with the group of signal stored in the memory 25 to see whether a match exists with any item in the group, i.e., retrieving data associated with the primary barcode), the controller being operative to conduct a search for a supplemental barcode label 20 based on the value associated with the retrieved value by scanning means 21 (figs. 4-5; col. 3, lines 38+ and col. 5, lines 60+).

Although, Kaslow teaches a scanning means 21 (fig. 5); he does not explicitly teach the specific optical components of the scanner, such as a laser for generating light and a video receiver assembly for detecting light.

Gupta teaches a scanner for detecting and decoding primary and supplemental bar code labels, comprising:

a laser/light source 152 for generating light (fig. 8; col. 10, line 53 through col. 11, line 2);

a video-receiver-assembly/light-receiving-element 153 for detecting light patterns produced by a reflection of the light generated by the laser from one or more bar code labels passing within a field of view of the video receiver assembly and producing data based on the light patterns (figs. 3 and 8; col. 10, line 53 through col. 11, line 2).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the laser light source and the video receiver assembly as taught by Gupta to the teachings of Kaslow in order to provide a better light source system for reading purposes i.e., laser light source provides more intense and precise reading

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accommodating with ambient light. Accordingly, such modification would have been an obvious extension as taught by Kaslow, and therefore an obvious expedient.

Re claim 2: Kaslow teaches the scanner, wherein the controller does not conduct a search for a supplemental label if the barcode represented by the primary barcode label is not found in the database (col. 5, lines 44+).

Re claim 3: Although Kaslow does not specifically state the default search operation, it would have been obvious to an artisan of ordinary skill in the art to incorporate an additional search operation, such as a default operation, to accurately match the product purchased with coupon product item closely as possible in an event that the product indicated is a general product and not specific to the product purchased. Accordingly, such modification would have provided better product redemption operation. Therefore, it would have been an obvious extension taught by Kaslow.

Re claim 4: Kaslow teaches the scanner, where the controller is operative to place the scanner in a supplemental label mode (second component or discount code 20) for a following scan only and upon detecting a primary label (first component or product code 19) to search for a supplemental label until a supplemental label is detected (col. 5, lines 39+).

Re claims 7, 9-10: Kaslow teaches a scanner for detecting and decoding primary and supplemental barcode labels, wherein the processing the UPC label data includes transferring the primary label data to a terminal connected to the scanner, and processing the supplemental label data includes transferring the supplemental label data to the terminal (fig. 5; col. 5, line 43 through col. 6, line 20).

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5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaslow as modified by Gupta as applied to claim 7 above, and further in view of Feng et al. (US 5,783,811; hereinafter "Feng"). The teachings of Kaslow as modified by Gupta have been discussed above.

Kaslow as modified by Gupta does not teach the process of providing operator feedback detection of the bar code label.

Feng discloses a portable data collection device having a two dimensional imaging assembly that can be actuated to read image having a bar code dataform (i.e., a primary label) by actuating the first trigger and by a separate trigger to record an image of signature dataform which serves as a second label (see col. 3, lines 45+). Wherein the primary and the secondary labels are located on a package (see figure 12). Upon detection of the primary label, the user can attempt to detect the secondary label by manually actuating the second trigger (i.e., selectively actuating the trigger) (see col. 3, lines 46+; col. 7, lines 1+; and figures 1-4). Therefore, upon a subsequent detection of the secondary label, processing of the primary label and the secondary label are achieved. Feng teaches the user detects the secondary label by manually actuating the second trigger after detecting the primary label. Feng also teaches the label processing system operates in one of a plurality of operation modes (i.e., reading mode and imaging mode) and wherein the system includes a means for selecting one of operation mode (i.e., the first trigger 26 and the second trigger 28 serves as a means for selecting one of the plurality of operation modes). The scanning device further includes a radio antenna 36 to transmit the capture data to the external device (see figure 1-4). Feng teaches the scanner having LED indicators 30, 32 to indicate a successful and unsuccessful reading, which serves as a means for providing operator

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feedback upon detection of the primary and secondary label (see col. 7, lines 25+; col. 16, lines 20+; col. 18, lines 43+; and figures 1-2).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the operator feedback feature as taught by Feng in the system of Kaslow as modified by Gupta in order to inform successful reading process of each bar code to the operator. Such operator feedback feature which provide a visual indication of each successful bar code reading would have provide a visual convenience to the operator and to provide a relief of monitoring the predetermined time delay between the primary and the secondary code reading.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gupta et al. (US 5,493,107) teaches shelf price label and product placement verification method and apparatus. Clark et al. (US 6,096,272) teaches automated microbiological testing apparatus and methods therefore. Brooks (US 5,440,110) teaches barcode scanner and method of scanning. Bravman et al. (US 5,401,944) teaches traveler security and luggage control system. Brooks (US 5,311,000) teaches barcode scanner and method of scanning.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 703-305-1798. The examiner can normally be reached on Monday-Friday 7:30-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-1341 for regular communications and 703-305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-8792.

KDN
March 4, 2003

Diane I. Lee
Diane I. Lee
Primary Examiner
GAU 2876